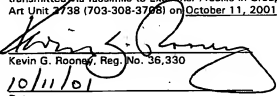


## PATENT

I hereby certify that this correspondence is being transmitted via facsimile to Examiner Prebilio in Group Art Unit 3738 (703-308-3738) on October 11, 2001

  
Kevin G. Rooney, Reg. No. 36,330  
10/11/01  
Date

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GROUP 3700

Applicants: Warren Williamson IV et al.  
Serial No.: 09/306,448  
Filed: May 6, 1999  
Art Unit: 3738  
Examiner: P. Prebilio  
Title: MEANS AND METHOD OF REPLACING A HEART VALVE  
IN A MINIMALLY INVASIVE MANNER  
Atty Docket: CVT-02

Cincinnati, Ohio 45202

October 11, 2001

RESPONSE

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

This responds to the Office Action mailed on September 28, 2001. In that Office Action, the Examiner issued three different rejections. First, claims 16-18 and 23-25 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Williamson, IV et al. (U.S. Patent No. 6,042,607), that is, a parent of the present application from which Applicants claim priority under 35 U.S.C. § 120. Second, claims 1-15, 19-22 and 26-27 were rejected as allegedly being

unpatentable over the Williamson, IV et al. patent mentioned above in view of Bachinski et al. (U.S. Patent No. 6,036,702). Third, claims 1-15, 19-22 and 26-27 were rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Williamson, IV et al. (U.S. Patent No. 5,716,370), that is, another related application from which Applicants claim priority under 35 U.S.C. § 120, in view of Bachinski et al. Applicants respectfully request that each of these rejections be withdrawn for the reasons set forth below.

First, with specific regard to the rejection under 35 U.S.C. § 102, Applicants claim the benefit of the '607 patent under 35 U.S.C. § 120. Therefore, if the subject matter of claims 16-18 and 23-25 is in fact fully disclosed in that patent, then the effective filing date for those claims is at least as early as the filing date of the '607 patent and the '607 patent cannot be an anticipatory reference under 35 U.S.C. § 102(e). This rejection should therefore be withdrawn.

With respect to both rejections under 35 U.S.C. § 103(a), Applicants' counsel notes the Examiner's position with regard to MPEP § 706.02(I)(2). In accordance with the requirements of that section, the Examiner is hereby informed that, at the time the invention of the present application was made, the present application and both parent patents, U.S. Patent Nos. 6,042,607 and 5,716,370, were either jointly owned by CardioVascular Technologies L.L.C. or, at the very least, subject to a legal obligation on the part of each inventor to assign both the subject matter of the parent patents and the claimed invention in the present application to CardioVascular Technologies L.L.C. at the time the claimed invention

was made. Although this statement, alone, suffices to fulfill the requirements of MPEP § 706.02(I)(2), Applicants' counsel has also attached copies of assignments from Warren Williamson IV, Paul A. Spence and George T. Chistakis dated February 10, 1996 and pertaining to all intellectual property "now owned or hereafter developed or acquired" by each assignor "relating to the development or commercialization of a device or procedure for mechanically fastening a sutureless heart valve and an artificial prosthesis." These assignments each extend to the presently pending application. In addition, Applicants' counsel has attached a copy of the Consulting Agreement executed by the fourth inventor, Mark Ortiz, on June 21, 1997. In paragraph 9, the agreement requires that Mr. Ortiz assign all the right, title and interest in and to any developments related to tools and instruments for cardiovascular surgery. See, also, paragraph 8. Mr. Ortiz's contributions to the subject matter claimed in the present application arose from and are subject to the provisions of the attached Consulting Agreement.

MPEP § 706.02(I)(2) states:

The questions of whether common ownership exists at the time the claimed invention was made is to be determined on the facts of the particular case in question. Actual ownership of the subject matter and the claimed invention by the same individual(s) or organization(s) or a legal obligation to assign both the subject matter and the claimed invention to the same individual(s) or organization(s) must be in existence at the time the claimed invention was made in order for the subject matter to be disqualified as prior art. A moral or unenforceable obligation would not evidence common ownership.

Applicants respectfully submit that the question of whether common ownership existed at the time the claimed invention of the present application was made has been answered in the affirmative in this case and, although not required, evidence has also been provided for the Examiner. Thus, the two Williamson IV et al. patents are disqualified as prior art under 35 U.S.C. § 103(c).

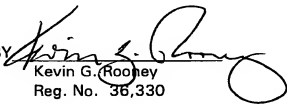
If there is any additional matter that may be resolved by telephone or fax, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicants do not believe that any fees are due in connection with this response. However, if such petition is due or any fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

BY

  
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